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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,901	10/16/2000	David Elberbaum	ELBX 17.815	1770
26304	7590	10/20/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			VENT, JAMIE J	
			ART UNIT	PAPER NUMBER
			2616	
DATE MAILED: 10/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,901

Applicant(s)

ELBERBAUM, DAVID

Examiner

Jamie Vent

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

Claims 1-23 of this application conflict with claims 1-17 and 19-32 of Application No. 09/759588. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim 1 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/759588 in view of Morito. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of the instant application corresponds to Claim 1 in application no 09/759788 with additional limitations of:

- Imprinting said exclusive code onto a label of said fresh disk by the code imprinter, the label being disposed on a surface opposite to a digital video signal data-recording surface of said fresh disk.

Morito discloses a method for authenticating the recording of digital video signals that are being recorded. Furthermore, Morito discloses in Column 3 Lines 38-45 describes the imprinting the exclusive code onto a label for allowing easy identification of recorded material. Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to use the imprinting of exclusive codes, as described in pending application 09/688901 and co-pending application 09/759588, and incorporate a system with imprinting the exclusive code onto a label, as described in Morito.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11, 13-16 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Morito (US6782190).

[claims 1, 3, 11, & 13]

In regard to Claims 1, 3, 11, and 13, Morito shows a method for authenticating the recording of digital video signals being recorded onto a fresh unrecorded disk by a disk recorder of a disk feeder system, the disk feeder system comprising coding generating and mixing means and a code imprinter, the method comprising the steps of:

- Feeding a fresh disk from a fresh disk compartment of the disk feeder system to code imprinter (Figure 2 shows the feeding of the disk as further described in Column 4 Lines 20-62);

- Generating an exclusive code for the disk by generating a mixing means (Figure 2 shows the printer 7 wherein the code is generated onto the disk as described in Column 4 Lines 38-45);
- Imprinting said exclusive code onto a label, the label being disposed on a surface opposite to a digital video signal (Column 3 Lines 38-45 describes the imprinting);
- Feeding the fresh disk imprinted with the exclusive code to the disk recorder (Figure 10 shows the feeding of the disk);
- Generating coded signals commensurate with the exclusive code by coding generating and mixing means (Figure 7 shows the generating of the code);
- Mixing said coded signals with said digital video signals recorder by said disk recorder to authenticate said recording of the recorded disk outputted from said feeder system (The disk identifier Sd is mixed on the disk with the coded signal Sp as seen in Figure 7).

[claims 2 & 4]

In regard to Claims 2 and 4, Morito et al discloses a method for authenticating the recording of digital video signals, wherein the disk feeder system is adapted for authenticating reading back of the digital video signals recorded from the recorded disk wherein said disk recorder further comprises a read back means and said disk feeder comprises a code reader, a code signal extractor and a comparator, said method comprises: loading said recorded disk into fresh disk compartment, feeding said

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recorded disk to disk recorder, reading the exclusive code, and reading the digital signals through the read back means (Figure 1o shows the above actions as described in Column 8 Lines 43+)

[claims 5, 6, 14, & 15]

In regard to Claims 5, 6, 14, and 15, Morito et al discloses a method for authenticating wherein the fresh disk comprises one of a non-erasable disk and re-recordable disk (Column 4 Lines 5-62 describes a DVD-R and Column 5 Lines 63-65 describes a DVD-RAM).

[claims 7, 16, 19, & 20]

In regard to Claims 7, 16, 19, and 20, Morito et al discloses a method for authenticating the recording of digital video signals wherein the code imprinter comprises one of a laser printer, an ink jet printer, a heat stamp printer, an ink pad printer, an optical/chemical printer, a ribbon printer, and a rubber page printer (Column 4 Lines 37-40 describes the imprinter).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10,12,17-18,21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morito (US 6782190) in view of Miller et al (US 6222800).

[claims 8,9,17, & 18]

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In regard to Claims 8, 9, 17, and 18, Morito discloses the imprinting of a code onto a fresh disk; however, fails to disclose the imprinting the code onto a label and placing the label onto the disk. Miller et al discloses a disk system wherein the disks are imprinted with a code onto a label and placing the label onto the disk as discussed in Column 1 Lines 1-15 and thereby providing a system that allows easy identification for the disk. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the imprinting disk system, as disclosed by Morito, and further disclose a system that labels the disk, as disclosed by Miller et al.

[claims 10, 12, 21, 22, & 23]

In regard to Claims 10, 12, 21, 22, and 23, Morito discloses a disk system; however fails to disclose a disk feeder apparatus. Miller et al shows a disk feeder apparatus as seen in Figure element 10, which comprises a controller as seen in the controller card 28. Furthermore, the disk recorder means comprises a disk driver 20, which records, a pull slider and slider table all comprised in the auto retrieve mechanism 26. Additionally the sliding table has an extended tray 22, pulley belt 78 wherein the shuttle 68 shuttle or slides the disk for transporting. The auto load separator mechanism 24 controls the ejection of the imprinted disk, as seen in Figure 12, as further described in Column 6 Lines 1-46. This apparatus allows for the processing and transporting of disks through recording and imprinting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the disk system, as disclosed by Morito, and incorporate a disk feeder apparatus that has transporting ability, as disclosed by Miller et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Oguro et al (6301430);
- Yamauchi et al (6295139).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamie Vent
09/30/05

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